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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,179	10/10/2003	Thorsten Kiehne	02/059 MFE	2584

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EXAMINER

CHEN, VIVIAN

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/684,179

Applicant(s)

KIEHNE ET AL.

Examiner

Vivian Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 November 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-15 and 17-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-15 and 17-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 8, 16 have been cancelled by Applicant.

Claim Rejections - 35 USC § 103

2. Claims 1-7, 9-15, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over EUROPEAN PATENT APPLICATION 1 176 004 (hereinafter EP '004),

in view of ENCYCLOPEDIA OF POLYMER SCIENCE (hereinafter POLYMER SCIENCE), and

in view of CULBERTSON ET AL (US 5,096,784).

EP '004 discloses a single-layer or multilayer film having the recited R-value, emax ratio, polyester compositions, symmetrical structures, fillers and/or white pigments such as titanium dioxide, thickness, method of making, and uses of said film. (see entire document, particularly paragraphs 0017-0021, claims) However, the reference does not explicitly disclose acrylic coatings.

POLYMER SCIENCE discloses that it is well known in the art to apply functional coatings to polyester films in order to improve slip properties (page 201).

CULBERTSON ET AL '784 discloses that it is well known in the art to apply crosslinkable aqueous acrylic coating to control the slip properties of polyester films wherein the acrylic coating contains an acrylic resin consisting of an acrylate copolymer containing self-crosslinking comonomers and wherein the coating further contains surfactants, wherein the

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coating has a typical coefficient of friction of 0.3-0.7. (line 17-43, col. 4; line 64, col. 6 to line 50, col. 8; line 42-45, col. 10)

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to apply known acrylic-based slip coatings as disclosed in CULBERTSON ET AL '784 to the polyester films of EP '004 in order to improve film-handling properties. One of ordinary skill in the art would have used conventional protective and/or coloration-modifying additives (e.g., UV absorbers, stabilizers, pigments, dyes, bluing agents, brighteners, etc.) to reduce undesirable yellowing (claim 14).

Response to Arguments

3. Applicant's arguments filed 11/22/2004 have been fully considered but they are not persuasive.

(A) Applicant's arguments regarding CULBERTSON ET AL '363 or KELLY or ULLMANN'S have been considered but are moot in view of the new ground(s) of rejection.

(B) Applicant argues that EP '004 and the other previously relied upon references each fail to explicitly disclose every single feature of the claimed invention. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). EP '004 discloses a majority of the features recited in the present claims. Those features not explicitly disclosed by EP '004 are features or modifications well

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known in the art as illustrated by the presently relied upon secondary references CULBERTSON ET AL '784 and POLYMER SCIENCE.

(C) In regard to Applicant's arguments regarding the use of encyclopedic references such as ULLMANN'S (and presumably POLYMER SCIENCE), such references are relied upon to illustrate and establish the general knowledge of one of ordinary skill in the art of polymeric films. Specifically, the references discuss well known problems and performance issues with polyester films, and illustrates conventional, well established methods of addressing such problems and issues (typically the use of appropriate additives and/or coatings with clearly known functions and benefits) and thereby provide clear motivation for one of ordinary skill in the art to combine the teachings of CULBERTSON ET AL '784 with EP '004 in order to further enhance the surface characteristics and overall performance of the EP '004 films. Applicant has not provided any probative evidence of criticality or unexpected results from the use of such well established practices in the art such the use of slip-improving coatings, color-modifying pigments, etc.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vivian Chen whose telephone number is (571) 272-1506. The examiner can normally be reached on Monday through Thursday from 8:30 AM to 6 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones, can be reached on (571) 272-1516. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

The General Information telephone number for Technology Center 1700 is (571) 272-1700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

February 3, 2005


Vivian Chen
Primary Examiner
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